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PATENT APPLICATION  
Docket No. 13914.420.2



UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of                      Scott R. Watterson and William T. Dalebout )  
Serial No.:                                      08/942,810                                      )  
Filed:    October 2, 1997                                      )  
For:     REORIENTING TREADMILL                                      )  
Examiner:                                         G. Richman    )

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BOX REEXAM  
Assistant Commissioner for Patents  
Washington, DC 20231

Dear Sir:

Responsive to the Office Action, dated November 22, 1999, please consider the following remarks.

**RESPONSE**

**A. Background**

Claims 21-37 are pending in this application. In the Office Action, the Examiner rejected all pending claims under 35 U.S.C. § 103(a) as being obvious in view of cited prior art. Applicant respectfully requests reconsideration of claims 21-37 in light of the following remarks.

**B. Rejection of Claims 21-37 under 35 U.S.C. § 103(a).**

1. **Claims 21-34.** Claims 21-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,664,646 issued to Rorabaugh (hereinafter "*Rorabaugh*") in view of U.S. Patent No. 4,370,766 issued to Teague, Jr. (hereinafter "*Teague, Jr.*"). In general terms, *Rorabaugh* discloses a support structure and a tread base rotatably attached to the support structure such that the tread base is selectively moveable between an operating position and a storage position. The Examiner acknowledges that *Rorabaugh* does not disclose a gas spring connected between the support structure and the tread base to assist in stably retaining the tread base when placed in the storage position. *Teague, Jr.* discloses a panel bed having a gas spring to assist in lifting the bed. The Examiner argues that it would have been obvious to combine *Rorabaugh* with *Teague, Jr.*

With reference to claims 22-24, the Examiner further mentioned that *Rorabaugh* discloses a motor mechanically coupled to the continuous belt, the tread base has a front end and a rear end wherein the tread base is rotatably attached to the support structure at a point adjacent the front end of the tread base and a flywheel.

With reference to claims 25, 29, 30, the Examiner further mentioned that *Teague, Jr.* discloses lift assist means and a pneumatic cylinder.

2. **Claim 35.** Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rorabaugh* in view of *Teague, Jr.* and further in view of U.S. Patent No. 4,026,545 issued to Schöeneberger (hereinafter "*Schöeneberger*"). The Examiner acknowledges that *Rorabaugh* and *Teague, Jr.* do not specifically detail a latch for securing the folding device, however *Schöeneberger* discloses a conventional catch means for securing a tread base when in the storage position. The Examiner argued that in light of *Schöeneberger*, it would have been obvious to use

*Schöneneberger's* catch means when *Rorabaugh* and *Teague, Jr.* devices are in the stored position. Further, the Examiner argues that it is well known to use a catch means, as taught by U.S. Patent No. 4,757,987 issued to Alleman (hereinafter "*Alleman*"), for holding a base frame in a storage position.

3. **Claims 36-37.** Claims 36-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rorabaugh* in view of *Teague, Jr.*, and further in view of U.S. Patent No. 5,207,622 issued to Wilkinson et al (hereinafter "*Wilkinson*"). The Examiner acknowledges that *Rorabaugh* and *Teague, Jr.* do not disclose feet rotatably coupled to a rear end of a tread base, for selectively varying the inclination of the tread base, however *Wilkinson* discloses feet rotatably coupled to a rear end of a tread base for selectively varying the inclination of the tread base. The Examiner argues that it would have been obvious to combine *Wilkinson's* means for adjusting the inclination of a tread base with *Rorabaugh*, as it is well known to use adjustable legs, as taught by *Wilkinson*, for changing the inclination of a tread base.

Applicant respectively traverses each of these rejections. To set forth a *prima facie* case of obviousness the following elements must be shown, according to M.P.E.P. § 2143:

- (1) suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify the reference or combine reference teachings;
- (2) . . .
- (3) the combined references must teach or suggest all the claim limitations of the Applicant's claims.

Additionally, the fact that the references can be combined is not sufficient to establish *prima facie* obviousness unless the prior art, in addition, suggests the desirability of the combination. M.P.E.P. § 2143.01.

As mentioned above, *Rorabaugh* is directed to a support structure and a tread base rotatably attached to the support structure such that the tread base is selectively moveable between an operating position and a storage position. Counsel for Applicant has earnestly studied the *Rorabaugh* patent, but has been unable to find any mention whatsoever, much less any discussion, of the need for a gas spring connected between the support structure and the tread base to assist in lifting the tread base from an operating position to a storage position. Accordingly, the *Rorabaugh* patent provides absolutely no suggestion or motivation for combining the references in the manner suggested by the Examiner.

*Teague, Jr.* discloses a counterbalancing mechanism for a panel bed (*i.e.*, a "Murphy bed") that uses a gas spring as part of the counterbalancing mechanism (Figures 2-4). Again, counsel for Applicant has earnestly studied the *Teague, Jr.* patent, but has found absolutely no reference to any teaching, suggestion or motivation directed, either explicitly or by implication, to the need or desirability of applying the counterbalance mechanism disclosed therein to any other application or field of art. Furthermore, Applicant respectfully submits that one skilled in the exercise equipment art would not logically look to prior art dealing with beds to obtain features or structures to be used with exercise equipment. **Further still, folding treadmills have been in existence for over 90 years (as evidenced by the *Day* patent), yet in all that time, no mention or discussion whatsoever is found in the cited prior art directed to the need or desirability of using a gas spring to assist in lifting the tread base from an operating position to a storage position, which Examiner maintains is so obvious.**

To be properly combinable, the cited references must teach or suggest some motivation for combining the references in the manner suggested by the Examiner. The Federal Circuit's recent

holding in *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), is instructive on this issue. *Dembiczak* involved a patent on an orange-colored garbage bag, having indicia printed on the outside of the bag so that, when full, it produces the appearance of a Jack-O-Lantern. Rejecting the claims under Section 103, the Examiner combined orange-colored garbage bags that were found to exist in the prior art with a prior art children's book teaching how to produce Jack-O-Lanterns from lunch sacks by drawing eyes, a nose and a mouth on the lunch sack. Reversing the rejection, the Federal Circuit set forth the following requirements on combining references under Section 103:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is **rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.** [citations omitted] **Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight.** [citations omitted]

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . . **The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.** [citations omitted] **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."**

*In re Dembiczak*, 50 U.S.P.Q.2d at 1617 (emphasis added).

In the present case, after briefly summarizing the basic teachings of *Rorabaugh* and *Teague, Jr.*, the examiner merely makes broad conclusory statements, unsupported by any factual basis or support, to the effect that it would have been obvious to combine the teachings of these two references from unrelated fields of art. Again, Applicant has earnestly studied the cited references and has been unable to locate any teaching, suggestion or motivation for combining the references in the manner proposed by the Examiner. Applicant respectfully requests the Examiner to point out, by

column and line numbers, any teaching or suggestion expressly set forth in the cited references that provides the requisite motivation necessary to combine the references in the manner suggested by the Examiner.

Applicant submits that it is improper for the Examiner, with the benefit of hindsight and armed with Applicant's invention as a road map, to indiscriminately pick and choose from among discrete and unrelated parts of the prior art (especially nonanalogous prior art) as a mosaic to recreate a facsimile of Applicant's invention. *Compare Akzo N.V. v. United States*, 808 F.2d 1471 (Fed. Cir. 1986).

Finally, in arguing that one skilled in the art may associate beds with exercise equipment, the Examiner points to U.S. Patent No. 4,679,787 issued to Guilbault (hereinafter "*Guilbault*"), which discloses a bed with lift assists where the bed can be lifted to a vertical position to expose stationary exercise equipment underneath the bed. In *Guilbault*, the stationary exercise equipment is collapsible to allow the bed to rest in a horizontal position. Based on the concern of user safety, the *Guilbault* patent emphasizes that the stationary exercise equipment chosen for this invention is "firmly fixed" in place, column 5, ll. 63-66. Further, once the person has finished exercising, the exercise equipment in *Guilbault* is described as being "collapsible" or "placed in the lowered position," column 6, ll. 5-6, 13-15. Counsel for Applicant has earnestly studied the *Guilbault* patent, but has been unable to find any mention whatsoever, much less any discussion, of the need for a lift assist for the stationary exercise equipment. The desirability of not having a lift assist with the stationary exercise equipment is evident in *Guilbault*. See M.P.E.P. § 2143.01 (the prior art must suggest the desirability of the combination). Otherwise, the bed would not be able to be placed in the horizontal position to hide the stationary exercise equipment. Thus, it would not be obvious to

one skilled in the art, based on the disclosure in *Guilbault* to provide a lift assist for treadmill equipment.

### CONCLUSION

In view of the foregoing, Applicant respectfully submits that the application is in condition for immediate allowance. Prompt, favorable action is, therefore, courteously requested.

In the event that the Examiner finds any remaining impediment to the prompt issuance of the pending claims, which could be remedied through a telephonic conversation, or which is susceptible to being overcome by means of an Examiner's Amendment, the Examiner is respectfully invited to initiate the same with the undersigned attorney.

DATED this 22<sup>nd</sup> day of May 2000.

Respectfully submitted,

  
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